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Please find below and/or attached an Office communication concerning this application or proceeding.

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JOHN R. SLOOP

Appeal 2010-006248
Application 10/625,146
Technology Center 1600

Before CAROL A. SPIEGEL, DONALD E. ADAMS, and
STEPHEN WALSH, *Administrative Patent Judges*.

ADAMS, *Administrative Patent Judge*.

DECISION ON APPEAL¹

This appeal under 35 U.S.C. § 134 involves claims 1, 27, and 28.² We have jurisdiction under 35 U.S.C. § 6(b).

¹ The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, or for filing a request for rehearing, as recited in 37 C.F.R. § 41.52, begins to run from the “MAIL DATE” (paper delivery mode) or the “NOTIFICATION DATE” (electronic delivery mode) shown on the PTOL-90A cover letter attached to this decision.

² Pending “[c]laims 2-8 and 22-26 have been withdrawn” as a result of a restriction requirement (App. Br. 2; *see also* January 11, 2008 Office Action 2).

STATEMENT OF THE CASE

The claims are directed to a wild animal control apparatus. The Examination of the claimed subject was limited to the elected species of the claimed invention. Specifically, wherein the attractant species is meat, the trigger is any component configured to dissolve at a pH of 0.5-5, and the subduing agent is any agent causing energy release, with the exception of a bullet or explosive device (January 11, 2008 Office Action 2). Claim 1 is representative and is reproduced in the “Claims Appendix” of Appellant’s Brief (App. Br. 13).

The rejections presented by the Examiner follow:

1. Claims 1, 27, and 28 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite.
2. Claims 1, 27, and 28 stand rejected under the written description provision of 35 U.S.C. § 112, first paragraph.
3. Claims 1, 27, and 28 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Fajt³ as evidenced by Getachew.⁴
4. Claim 1 stands rejected under 35 U.S.C. § 102(b) as anticipated by or, in the alternative, under 35 U.S.C. § 103 as obvious over Shulyer.⁵

We affirm the rejection of claim 1 under 35 U.S.C. § 102(b) as being anticipated by Fajt as evidenced by Getachew. However, because our rationale differs from that of the Examiner, we designate our affirmance as a new ground of rejection. We affirm the rejection of claim 1 under 35 U.S.C.

³ Fajt, US 5,674,518, Oct. 7, 1997.

⁴ T. Getachew, *Stomach pH, feeding rhythm and ingestion rate in Oreochromis niloticus L. (Pisces/Cichlidae) in Lake Awasa, Ethiopia*, 174 HYDROBIOLOGIA 43-48 (1989).

⁵ Shulyer, US 2,957,804, Oct. 25, 1960.

§ 102(b) as anticipated by or, in the alternative, under 35 U.S.C. § 103 as obvious over Shulyer.

We reverse the rejections under 35 U.S.C. § 112, first and second paragraphs. We reverse the rejection of claims 27 and 28 under 35 U.S.C. § 102(b) as being anticipated by Fajt as evidenced by Getachew.

Definiteness:

ISSUE

Is the relationship between the trigger and subduing agent as set forth in Appellant's claimed invention reasonably clear to a person of ordinary skill in the art when read in light of Appellant's Specification?

FINDINGS OF FACT

FF 1. According to the Examiner's restriction requirement, the trigger of Appellant's claimed invention is any component configured to dissolve at a pH of 0.5-5 (January 11, 2008 Office Action 2).

FF 2. For clarity we reproduce Appellant's figure 8 below:

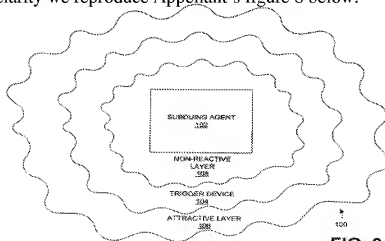


FIG. 8

FIG. 8 depicts an embodiment of Appellant's claimed invention, wherein

the subduing agent 102 may comprise a metal, chemical, a plurality of metals, a plurality of chemicals, or any combination

thereof. . . . When the trigger device 104 reacts and dissolves, and after nonreactive layer 108 dissolves, the subduing agent 102 releases reacts in the target wild animal's stomach. The reaction between the subduing agent 102 and the body of the target wild animal . . . results in the death or incapacitation of the target wild animal . . . due to the energy release of the subduing agent 102.

(Spec. 12-13: ¶ [0035].)

ANALYSIS

The Examiner finds that Appellant's "invention as claimed presents no distinct coupling agents or means as to how the subduing agent is coupled to the trigger, or what the trigger is" (Ans. 8). However, as defined by the Examiner's restriction requirement, the trigger is any component configured to dissolve at a pH of 0.5-5 (FF 1). Appellant's Specification describes the relationship between the trigger and the subduing agent (*see e.g.*, FF 2). Accordingly, we agree with Appellant's contention that "there is no ambiguity in the claims or specification" (Reply Br. 5).

CONCLUSION OF LAW

The relationship between the trigger and subduing agent as set forth in Appellant's claimed invention is reasonably clear to a person of ordinary skill in the art when read in light of Appellant's Specification. The rejection of claims 1, 27, and 28 under 35 U.S.C. § 112, second paragraph is reversed.

Written Description:

ISSUE

Does the preponderance of evidence on this record support the Examiner's conclusion that Appellants' Specification fails to provide written descriptive support for the claimed invention?

FINDINGS OF FACT

FF 3. Appellant's Specification discloses that

One of ordinary skill would know that varied quantities of the subduing agent 102 may be used to achieve the desired effect for the desired target wild animal. As a non-limiting example, a larger or smaller quantity of subduing agent 102 (*i.e.*, sodium, potassium, or lithium) may be used to subdue an alligator as opposed to a coyote or a wild hog.

(Spec. 12: ¶ [0036].)

ANALYSIS

The Examiner finds that Appellant's device does not preclude "dogs, cats & rats from being attracted & killed by" Appellant's device (Ans. 5). The Examiner finds that Appellant's "[S]pecification does not present exemplification of effectiveness to subdue one species, but not harm another" (*id.* at 6). We agree, however, with Appellant's contention that there is no requirement in the claims that precludes non-target animals from being subdued by the control apparatus or that "the subduing agent only subdues one species" (Reply Br. 3).

While the Examiner finds that Appellant's Specification exemplifies the use of sodium, potassium, or lithium as energy release agents, the Examiner finds that Appellants' Specification fails to explain "how much of what components are to be used to subdue a desired species" (Ans. 5-6). Appellant's Specification, however, discloses that the determination of the quantity of subduing agent utilized depends on the target animal and is known to a person of ordinary skill in this art (FF 3). The Examiner has not provided persuasive evidence or argument to support a conclusion that Appellant's Specification is not correct.

The Examiner finds that “[t]he metal subduing agents were not presented in any shape, form, or amount, in connection with any specific trigger material and meat or other attractant material, to enable one of ordinary skill to practice the claimed invention” (Ans. 6). We are not persuaded. The claims do not require the subduing agent to exhibit a particular shape or form. As discussed above, the Examiner failed to rebut Appellant’s disclosure that the amount of subduing agent required for a particular application is known to a person of ordinary skill in this art. That said, we recognize that the ground of rejection presented to this panel by the Examiner is under the written description provision, not the enablement provision, of 35 U.S.C. § 112, first paragraph. To the extent that the Examiner intended to reject the claims under the enablement provision of 35 U.S.C. § 112, first paragraph, the Examiner failed to provide a persuasive evidentiary basis to support such a rejection.

Lastly, the Examiner finds that Appellant provides “no specific compound, material or composition of the trigger, thus it is beyond the capabilities of one of ordinary skill in the art of formulating wild animal control apparatus’ [sic] to know what to use as a trigger & how to couple it to the subduing agent and attractant” (Ans. 7). We are not persuaded for the reasons set forth on pages 4 and 5 of Appellant’s Reply Brief.

CONCLUSION OF LAW

The preponderance of evidence on this record fails to support the Examiner’s conclusion that Appellant’s Specification fails to provide written descriptive support for the claimed invention. The rejection of claims 1, 27, and 28 under the written description provision of 35 U.S.C. § 112, first paragraph is reversed.

Anticipation:

ISSUE

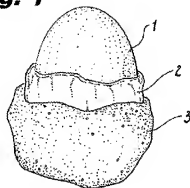
Does the preponderance of evidence on this record support the Examiner's finding that Fajt teaches the claimed invention as evidenced by Getachew?

FINDINGS OF FACT

FF 4. Fajt teaches a formulation wherein fish feed and a target species attractant are combined to form poison oral bait pellets to selectively exterminate a target species by ingestion without poisoning the aqueous environment (Fajt, Abstract).

FF 5. For clarity, we reproduce Fajt's figure 1 below:

Fig. 1



“FIG. 1 is a cut-away view of a poison bait pellet” according to Fajt's invention (Fajt, col. 2, l. 11).

FF 6. The core 1 of Fajt's “pellet contains the toxicant either in its solid form or, in the case of liquid toxicants, absorbed into a solid matrix” (Fajt, col. 2, ll. 18-19).

FF 7. Rotenone is used as the toxicant in a preferred embodiment of Fajt's invention (Fajt, col. 2, ll. 44-45). In this regard Fajt teaches a formulation

that comprises rotenone with or without an adsorption agent such as an antacid (Fajt, col. 6, l. 61 – col. 7, l. 26).

FF 8. The core of Fajt's pellet may "be coated with a water resistant gel layer 2 to prevent leaching of the toxic formulation into the aqueous environment" (Fajt, col. 2, ll. 24-26).

FF 9. "Encapsulating the entire core [of Fajt's pellet] is a fish-food layer 3 that may be simple fish-food but is preferably an attractant selective for the target species," such as "fish meal, blood meal, or beef by-products" (Fajt, col. 2, ll. 34-36 and col. 6, l. 37).

FF 10. Fajt teaches that a fish's stomach has a low or acidic pH (Fajt, col. 4, ll. 18-19).

FF 11. Getachew teaches that pH values of 1.4 and 1.5 are very common for *Oreochromis niloticus* L. (Pisces: Cichlidae) (Getachew 44, col. 2).

ANALYSIS

We are not persuaded by the Examiner's assertion that Fajt's teaching of surfactants and metal hydroxides to increase the absorption of a toxin can be considered energy releasing agents within the scope of Appellant's subduing agents as required by Appellant's claimed invention (*see* Ans. 9).

Nevertheless, applying a different rationale, we agree with the Examiner's finding that Fajt anticipated Appellant's claim 1. Accordingly, for the reasons set forth below, we affirm the rejection of Appellant's claim 1 as a new ground of rejection.

Appellant's claim 1 is drawn to a wild animal control apparatus that comprises an attractant, a trigger and a subduing agent. Fajt teaches a control apparatus that comprises a core, a gel layer, and a fish food layer (FF 4-9).

Appellant's claim 1 requires "an attractant configured to entice a target wild animal to consume the wild animal control apparatus" (Claim 1). Fajt's fish food layer serves as "an attractant selective for the target species" (FF 9).

Appellant's claim 1 requires a trigger covered by a portion of the attractant, the trigger adapted to dissolve in an environment having a predetermined pH (Claim 1). Fajt's pellet comprises a water resistant gel layer that "prevent[s] leaching of the toxic formulation into the aqueous environment" (FF 8). Appellant contends that since Fajt does not indicate that the gel layer dissolves in an environment with a predetermined pH, Fajt cannot anticipate Appellant's claimed invention (App. Br. 9; Reply Br. 6). We are not persuaded.

Fajt's gel layer prevents the toxin from leaching into the aqueous environment, e.g., a pond, stream, etc. Fajt's gel layer allows the toxic core to be released in the stomach of a fish (FF 4 (a target fish species is exterminated by ingesting the poison)). The stomach of a fish has a low or acidic pH (FF 10-11). Taken as a whole, Fajt teaches a trigger (a gel layer) that prevents the release of toxin in one environment, but allows the toxin's release in another environment (e.g., the acidic pH environment of a fish's stomach). Since it is known that the stomach of a fish has a low or acidic pH, the selective release of the toxin in a fish's stomach is obtained at a predetermined pH (e.g., a low or acidic pH).

Like Appellant's claim 1, the core of Fajt's pellet contains a toxin or subduing agent, which is encapsulated by (or coupled to) a gel layer trigger. As discussed above, like Appellant's claim 1, the subduing agent is adapted to subdue the fish (e.g., wild animal) that consumes the apparatus once fluids

in the digestive system of the fish having a predetermined low or acidic pH cause the trigger to dissolve, wherein the subduing agent is released (e.g., activated) and the wild animal is subdued. We are not persuaded by Appellant's focus on rotenone and Fajt's corresponding disclosure that chemicals that neutralize the digestive acids of the target fish should be utilized in combination with rotenone (App. Br. 9). Fajt discloses rotenone as a preferred toxin, not the sole toxin that can be used in the Fajt's formulation (FF 7). In this regard, Appellant failed to establish that other toxins useful in Fajt's invention require a neutralization of stomach acid. Further, Fajt does not require neutralization of stomach acid, but instead discloses embodiments that contain and exclude an antacid (*id.*).

We do, however, recognize that the foregoing discussion steps outside of the Examiner's restriction requirement, which limits the subduing agent to any agent causing energy release, with the exception of a bullet or explosive device (January 11, 2008 Office Action 2). The Examiner failed to establish that a toxin within the scope of Fajt's disclosure is an energy release device.

Because claims 27 and 28 are expressly limited to an apparatus which comprises an energy release device, we are compelled to reverse the rejection of these claims.

CONCLUSION OF LAW

The preponderance of evidence on this record supports the Examiner's finding that Fajt, as evidenced by Getachew, teaches the subject matter of Appellant's claim 1. The rejection of claim 1 under 35 U.S.C. § 102(b) as being anticipated by Fajt as evidenced by Getachew is affirmed. The preponderance of evidence on this record fails to support the Examiner's finding that Fajt, as evidenced by Getachew, teaches the subject

matter of Appellant's claims 27 and 28. The rejection of claims 27 and 28 under 35 U.S.C. § 102(b) as being anticipated by Fajt as evidenced by Getachew is reversed.

Anticipation/Oviousness:

ISSUE

Does the preponderance of evidence on this record support the Examiner's finding that Shulyer teaches the claimed invention or conclusion that Appellant's claimed invention is obvious in view of Shulyer?

FINDINGS OF FACT

FF 12. The Examiner finds that Shulyer teaches or in the alternative suggests the subject matter of Appellant's claim 1.

ANALYSIS

We agree with the Examiner's findings. Appellant fail to address this rejection. Since Appellant failed to identify error in the rejection of record, we are compelled to affirm.

CONCLUSION OF LAW

The preponderance of evidence on this record supports the Examiner's finding that Shulyer teaches the claimed invention or conclusion that Appellant's claimed invention is obvious in view of Shulyer. The rejection of claim 1 under 35 U.S.C. § 102(b) as anticipated by or, in the alternative, under 35 U.S.C. § 103 as obvious over Shulyer is affirmed.

TIME PERIOD FOR RESPONSE

Regarding the affirmed rejection, 37 C.F.R. § 41.52(a)(1) provides "Appellant may file a single request for rehearing within two months from the date of the original decision of the Board."

In addition to affirming the Examiner's rejection of claim 1 under 35 U.S.C. § 102(b) as anticipated by or, in the alternative, under 35 U.S.C. § 103 as obvious over Shulyer, this decision contains a new ground of rejection pursuant to 37 C.F.R. § 41.50(b) (effective September 13, 2004, 69 Fed. Reg. 49960 (August 12, 2004), 1286 Off. Gaz. Pat. Office 21 (September 7, 2004)). 37 C.F.R. § 41.50(b) provides "[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review."

37 C.F.R. § 41.50(b) also provides that the Appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

(1) Reopen prosecution. Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner....

(2) Request rehearing. Request that the proceeding be reheard under § 41.52 by the Board upon the same record....

Should the Appellant elect to prosecute further before the Examiner pursuant to 37 C.F.R. § 41.50(b)(1), in order to preserve the right to seek review under 35 U.S.C. §§ 141 or 145 with respect to the affirmed rejection, the effective date of the affirmance is deferred until conclusion of the prosecution before the Examiner unless, as a mere incident to the limited prosecution, the affirmed rejection is overcome.

If the Appellant elects prosecution before the Examiner and this does not result in allowance of the application, abandonment or a second appeal,

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this case should be returned to the Board of Patent Appeals and Interferences for final action on the affirmed rejection, including any timely request for rehearing thereof.

AFFIRMED; 37 C.F.R. § 41.50(b)

cdc

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